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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Jacques DUMAS et al.

Confirmation No.: 8328

Serial No.: 09/458,014

Examiner: Yong Soo Chong.

Filed: December 10, 1999

Group Art Unit: 1617

Title: INHIBITION OF P38 KINASE USING ACTIVITY SUBSTITUTED HETEROCYCLIC UREAS

REPLY TO RESTRICTION REQUIREMENT

Mail Stop: Non-Fee Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Requirement of Restriction in the above-identified application, Applicants elect Group I, claims 1-4, 28-34, 37-38, 42-51, 54-55 and 57, drawn to a method of treating rheumatoid arthritis by administering a 1,3 oxazole according to formula I. Applicants traverse the requirement of Restriction in that no reasons have been provided for the requirement and in addition, the restriction requirement is inconsistent with 35 U.S.C. §121.

The Examiner alleges that the claims define seven unrelated inventions drawn to various diseases with different etiologies, symptoms and treatment regimens. The Examiner also alleges that, "The search for one will not lead to a search of the other." This appears to be inconsistent with the classification scheme of the seven inventions in that all are said to be classified in the same group class and subclass, class 514 and subclass 385. In addition, the alleged distinctions between the seven inventions do not pertain to any claim element. The

etiologies, symptoms and treatment regimens of the diseases treated are not recited in any of the claims.

Furthermore, the Examiner has required restriction within a single claim. Applicants respectfully submit that 35 U.S.C. § 121 does not permit restriction within a single claim as clearly indicated by the Court in *In re Weber et al.* 198 USPQ 328 (1978).

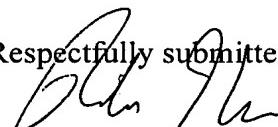
As a general proposition, an Applicant has a right to have each claim examined on the merits. If an Applicant submits a number of claims, it may well be that pursuant to a proper restriction requirement, those claims will be disbursed to a number of applications. Such action should not affect the right of the Applicant eventually to have each of the claims examined in the form he considers to best define his invention. If however a single claim is required to be divided up and presented in several applications, that claim would never be considered on its merits.

It is apparent that §121 provides the commissioner the authority to promulgate rules designed to restrict an application to one of several claimed inventions when these inventions are found to be "independent and distinct." It does not however provide a basis for an Examiner acting under the authority of the Commissioner to reject a particular claim on that basis.

The Restriction Requirement in the above-identified application dated May 10, 2007, is exactly the action that the Court *In re Weber* stated was not permitted under 35 U.S.C. §121. Such action by an Examiner would violate the "basic right of an Applicant to claim his invention as he chooses." Since claim 1 does not actually recite the separate diseases identified in the seven groups, but instead defines these diseases under one label, "a disease mediated by p38 other than cancer," there is clearly unity of invention for the subject matter defined by this language. For the reasons indicated above, Applicants respectfully submit the restriction should be withdrawn.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,


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Date: June 11, 2007